

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

Claims 1-10 have been rejected under 35 U.S.C. 112, second paragraph. These claims have been amended to change "structure" to "composition of matter"; the term "preferably" has been removed from claim 2, and claim 1 has been amended to recite $n \geq 0$ which corresponds to an "alyl" as claimed. In view of these changes and comments, withdrawal of this rejection is respectfully requested.

Claims 1-3 have been rejected under 35 U.S.C. 112, first paragraph. The Examiner states:

"The specification lacks adequate support and enablement for all polar functionalities and only gives a few examples which is not seen how this cannot be extrapolated to all polar functionalities without reasonable evidence that all would work as claimed, especially in light of the fact that the behavior of a given chemical group in certain or particular environments are usually unpredictable. Hence, it would require undue experimentation for one of ordinary skill in the art at the time the application was filed to find out which polar functionalities other than those disclosed would work as claimed. As a result, the enablement for this term is not commensurate in scope to the claims as recited."

Applicants respectfully disagree. It is well known how to add groups to organic molecules and only well known routine experimentation is needed as stated in the

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attached Affidavit of Dr. Buckwalter under 35 CFR 1.132. Thus, Applicants claims are enabled.

"Showing that the disclosure entails undue experimentation is part of the PTO's initial burden." In re Armbruster 185 USPQ 152, 504.

"The practical approach followed consistently by [the CCPA] ..., places the initial burden on the PTO to show that the enabling disclosure is not commensurate in scope with the claim. Upon such a showing, the burden of rebuttal shifts to applicants". In re Coliani 195 USPQ 150.

"However, [the CCPA] has made it clear that the Patent and Trademark Office must substantiate its rejections for lack of enablement with reasons" In re Armbruster 185 USPQ 152, 153.

The Examiner has merely asserted without support that "it would require undue experimentation for one of ordinary skill in the art at the time the application was filed to find out which polar functionalities other than those disclosed would work as claimed."

The CCPA in In re Marzocchi, 58 CCPA 1069, 439 F. 2d 220, 169 USPQ 367, 369-370 (1971) states:

"The only relevant concern of the Patent Office under these circumstances should be over the *truth* of any such assertion. The first

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paragraph of §112 requires nothing more than objective enablement. How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance.

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of §112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching contained in the specification is truly enabling...

[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. [Emphasis in original footnote deleted].

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Following the CCPA in In re Marocchi, the Examiner has not shown any reason to "doubt the objective truth of the statements contained [in Applicants' specification] which must be relied on for enabling support." In in re Marocchi, the CCPA has stated that "broad terminology" is sufficient for their to be enablement. That Applicants' specification enables Applicants' claims is conformed by the Affidavit of Dr. Buchwalter.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

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Respectfully submitted,

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